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<u>Who is doing what ?</u>

Firstly, we note that it is the function of the specification, not the claims, to set forth the "practical limits of operation" of an invention. In re Rainer, 49 CCPA 1243, 1248, 305 F.2d 505, 509, 134 USPQ 343, 346 (1962). One does not look to claims to find out how to practice the invention they define, but to the specification. In re Roberts, 470 F.2d 1399, 1403, 176 USPQ 313, 315 (CCPA 1973); In re Fuetterer, 50 CCPA 1453, 319 F.2d 259, 138 USPQ 217 (1963). In this case for clarity we have provided the following chart and examples found in the specification.

Element - in part indicative only (for full refer to claim 1)	who/what is performing	Source in Specification
providing at least a centralized payment processor etc	Telecommunication Service provider or neutral third party ('middleman')(payment processor is structural limitation)	Fig 3 and page 11 and 12
extending main processor for establishing sub-accounts for payer and payee etc	Telecommunication Service Provider System extends and User establishes. Note the 'work piece' is main processor for said provider which is a structural limitation.	See Fig 4 and page 12 for definition of sub-account. "The sub account is a "virtual" account separating entries between real telecommunication cost and other transactions etc."
receiving the payer's account	payment processor is	page 14 line 19 - 23

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identifier, transfer amount etc	receiving, payer is sending	
establishing a connection etc	by payment processor	page 15 line 4-6 "...Payment Processor 40... by calling and connecting to the provided mobile number sent by the customer 70"
sending a password, second network etc	by payer	page 6 and 7
authenticating etc	by telecommunication system since said data is stored at telecommunication provider system via payment processor.	page 16 line 1-6 and page 22 under heading "3. Account authentication"
recording a debit and credit in sub account etc	by respective telecommunication service provider as sub-account is found in provider's main processor. However instructions issuance controlled by payment processor.	page 6 and page 17 line 13 to 15. "This credit connection 58 and debit connection 59 are performed by Payment Clearing, Settlement and Reporting Services 50 through connection

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		62 and controlled by Payment Processor 40"
payer's account is non prepaid etc	Limitation	

Note the payment processor can be integrated into the telecommunication service provider's computer. (See specification page 11 line 19 and we quote "It is important to note that this payment processor 40 may be coupled with or as part of an extension of at least one telecommunication carrier main central processor rather than as an individual entity as depicted here.").

The Action Letter then expressly suggest that for examination purpose, elements which are found to be indefinite will nevertheless be equated to "billing platform and the steps of extending, establishing, sending, an ISP with an authentication service performs authenticating" (Action Letter page 3) The Applicant respectfully submits that this practice is questionable as it can result from looking to what *should* have been claimed rather than what *is* claimed. See, Reiffin v. Microsoft Corp., 214 F.3d 1342, 1348 (Fed. Cir. 2000) (Calling into question the so-called "omitted elements test."). By omitting these elements for examination purpose, the examiner has reconstructed our claimed invention into what it is not. For example, ISP is not found in our specification and ignores our payer to payee fund transfer using sub account "subject matter". Furthermore, the examiner placed no knowledge on record why must he equate this to a "billing platform and the steps of extending, establishing, sending, an ISP with an authentication service performs authenticating." It may also be a pure coincidence that both prior arts presented Woodhill and Ronen appear to have these 'elements' which could suggest that such equating was not done without the benefit of hindsight.

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The positive test in 35 USC 112 (Second para) is namely that subject matter set out in the claims must be presumed, in the absence of evidence to the contrary, to be that which the applicant regards as his invention. Thus, the burden of proof is upon the Patent and Trademark Office to demonstrate that the claims do not comply with 35 USC 112, second paragraph. See In re Moore, 58 CCPA 1042, 1046, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (1971). It is clear that the examiner had not discharged this task by asking the question who is doing what as the answer is in the specification ? To show there is an issue, the examiner need to provide evidence to the contrary against what the claims must presume and not MERELY ask who is doing what as this clearly shows the examiner is aware of the subject matter the applicant regards as his invention but not the practical limits. Hence by asking who is doing what is merely for clarification and not amounting to presenting evidence to the contrary. As stated previously 'how to practice' the invention is found in the specification and not in the claims. In case, the examiner may wish to bring up 112 Para 1 in the alternative, it should be noted that the elements "extending and establishing" are originally found in the claim application at date of filing. In Re Gardner 475 F.2d 1389, (CCPA 1973),: Originally filed claims provide their own description and, hence, automatically meet the "written description" requirement of 35 U.S.C. §112. Importantly, the CCPA further held that, "Nothing more is necessary for compliance with the description requirement of the first paragraph of 35 U.S.C. §112." 475 F.2d at 1391. (Emphasis supplied.)

Claim 1, 21, 28 in view of the word "Main"

Referring to the word "main" as asserted to fail to comply with 35 USC 112 Para 2 at page 3 of Action Letter. The examiner states that the word "main" is a relative word and hence indefinite. It is also asserted the word 'main' is not defined in the claim(s) nor found in the specification and therefore one skilled in the art will fail to ascertain the scope of the invention. The examiner asserted that in terms of the specification, " the specification does not provide a standard for ascertaining the requisite degree" and

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therefore "one ordinary skill in the art would not be reasonably appraised of the scope of the invention".

The application disagree. MPEP 2173.05(b) states that "If it does not, a determination is made as to whether one of ordinary skill in the art, in view of the prior art and the status of the art, would be nevertheless reasonably apprised of the scope of the invention. Even if the specification uses the same term of degree as in the claim, a rejection may be proper if the scope of the term is not understood when read in light of the specification."

The examiner made no such determination as required and only concluded this is so. By simply citing there is no standard for ascertaining does not by itself is conclusive one skilled in the art will fail to ascertain the scope of the invention. Without stating why this term is not understood in light of the specification, the examiner had not made out the prima facie case required. A claim is indefinite where those skilled in the art would not understood what is claimed when reading the claim language in light of the specification and prosecution history. (Amgen Inc v Chugai Pharmaceutical Co., 927 F.2d 1200, 1218, 18 USPQ 2d 1016, 1030 (Fed Cir)., Cert denied, 502 US 856 (1991))

Firstly is 'Main' a word of degree ?

A word of degree for example is "substantially equal to" as found in the case Seattle Box v. Industrial Crafting & Packing Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984). However, "main" is not relative in degree to importance or significance, main is defined by WordNet ® 2.0, © 2003 Princeton University

adj 1: most important element; "the chief aim of living"; "the main doors were of solid glass"; "the principal rivers of America"; "the principal example"; "policemen were primary targets" [syn: chief(a), main(a), primary(a), principal(a)] 2: of a clause; able to stand alone syntactically as a complete sentence; "the main (or independent) clause in a

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complex sentence has at least a subject and a verb" [syn: independent, main(a)] [ant: dependent] 3: of force; of the greatest possible intensity; "by main strength" [syn: main(a)] n 1: any very large body of (salt) water [syn: briny] 2: a principal pipe in a system that distributes water or gas or electricity or that collects sewage

'Main' therefore signifies 'most important' which means it can only be ONE known to be most important. For example, if one skilled in the art is asked, which is the most important account and he could reply to this then the claim is definite. Note also reference shows 2 type of accounts, sub and main as explained below.

Noting here that in Claim 1, the word main appears in two instances being 'main processor' and 'main telecommunication account'. Again in both cases, the words are originally filed as claimed so in view of Re Gardner (supra) they would have satisfied Para 1 of USC 112 (written description).

With regards to Para 2 of USC 112, the examiner did not provide any counter example of the many types of accounts could be found from the telecommunication industry which makes it relative to another to show indefinite in view of the specification which spells out only two type of accounts, being sub-account and main account see Fig 4. The Applicant submits that if relativity is based on 'importance' or "ranking" then having explained in the specification what a sub-account is then sure one skilled in the art of account will be able to see that a sub-account must be a derivative of a main account which means the sub-account is a separate entity as compare to the main. Furthermore, the examiner provided no evidence to show why one skilled in the art of Accounting could fail to recognise the sub-main account combination.

The Applicant directs the examiner to consider this paragraph found from US Bureau of Reclamation, a govt website http://www.usbr.gov/recman/fin/0720b12.htm which we copied on 6 Jan 2006. (See Exhibit 1)

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under 12. Investigations and Development.

under B. Policy

2 (b) (ii) In some cases, investigations costs may be posted directly to the CIP account, such as when capital investigations costs are incurred after the criteria is met for transfer from the investigations and development account to CIP (2.d.). Investigations costs posted directly to the CIP account shall be recorded in the construction/plant account (main) and account component (sub), 001 92 00, specified for investigations and development costs.

and

F. Investigations and Development Costs Incurred After CIP Account has Been Established. Once the criteria has been met for transfer from investigations and development to CIP (2.d.), all subsequent investigations and development costs attributable to project construction should be charged directly to the CIP account (SGL 1720). Investigations costs posted directly to the CIP account shall be recorded in the construction/plant account (main) and account component (sub), 001 92 00, specified for investigations and development costs.

The cited authority used is Federal Accounting Standards Advisory Board (FASAB), Statement of Federal Financial Accounting Standards (SFFAS) No. 6, *Accounting for Property, Plant, and Equipment (PP&E)*; U.S. Treasury Standard General Ledger (SGL); and the Financial Accounting Standards Board (FASB) Concept 6, *Elements of Financial Statements*.

The Applicant also included another source at www.usbr.gov/recman/fin/0720_b4.htm in FULL for the benefit of the examiner labeled as Exhibit 2. Therefore, it could not said that such terminology and relationship of 'main and sub' accounts are not known in Accounting art by the US Government. At the very least knowing where the sub account came from will definitely linked to the main account is clear.

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In Exhibit 3, the Applicant provides the Australian government version of main and sub accounts for banking industry and we quote the relevant section below. (downloaded 6 Jan 2006)

Sub Accounts

Agencies may consider using sub accounts, i.e. an internal split of accounts under a main account, to manage transactions. These are not recognised as separate accounts by the transactional banker, who reports on the main account. They are accounts, which are split in a system whereby cheques and serial numbers (payments and receipt references) can be specified as belonging to particular sub accounts, and therefore reported as such.

http://www.finance.gov.au/finframework/docs/ABFM_April_2005.pdf
at page 16.

In Exhibit 4, the Applicant provides a terms of usage found at website http://www.ibackup.com/terms_new.htm (downloaded 6 Jan 2006) and we quote the relevant section "(d) If sub-accounts are created by the main account holder, the main account holder is responsible for all the actions arising from the sub-account holders, and will make sure that all the terms and conditions described here are adhered to by the sub-account holders."

In Exhibit 5, the Applicant provides the FORM EF as copied from International Civil Aviation Organization at www.icao.int/icao/en/atb/sea/form_ef.pdf which basically shows sub-accounts and main accounts being asked for carrier's Profit and Loss Statements. This was downloaded 6 Jan 2006.

In Exhibit 6, the Applicant provides a webpage download 6 Jan 2006 from www.hitslink.com/statistics-features.aspx which we quoted below

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Sub-Accounts

For consultants or webmasters with many sites, you can add unlimited sub-accounts to your main account. This consolidates billing under the main account and provides substantial cost savings.

Each sub-account has its own private login and password. Sub-accounts cannot see other sub-accounts, so privacy is maintained.

In Exhibit 7, the Applicant provides a page from CarolinaNewswire.com which we quote as follows "If, however, the chart of accounts was established with a Travel category (main account) and sub accounts (airfare, lodging, etc.), then the organization has the option of printing a summary report (Travel) or a detailed report (airfare, lodging, etc.). Although there is some difference in the effort required to enter transactions at the detail level of specific accounts versus lumping everything into the single travel account at the time of entry, there is a tremendous difference in the effort required to answer analytical and management queries at a later date. It requires far less effort to drill down into already available detailed accounts to understand the spending patterns and issues that it does to create those accounts from one main category before the analysis can begin. "

The URL is
http://carolinanewswire.com/news/News.cgi?database=topstories.db&command=viewon e&id=3029

and we downloaded 6 Jan 2006.

In exhibit 8, the Applicant included a page from University of Wisconsin, Madison at page 3 of said exhibit.

See under header : **Funds (money) availability in 133 and 144 project/grants:**

A second option is the creation of sub-accounts. For projects with complex accounting or programmatic requirements, a single account is not practical. In those cases, multiple accounts can be created—each with its own budget and spending authority. These "sub-accounts" are linked in ESIS through the use of the "senior account" field. All related sub-accounts share the same reference information in their "senior account" field.

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Source : http://www.bussvc.wisc.edu/acct/policy/payment/transfer_pro.html (download 9 Jan 2006)

Note that although they use "senior account" this is like our main account in our specification.

Therefore the Applicant submits that it cannot be said that the terminology 'main and sub' is unknown to those skilled in the art of accounting such that it is seen as indefinite. In fact, the Applicant as a Professional Accountant in Australia (Associate of Society of Accountants) can attest that such usage of sub-accounts and main accounts are commonly known particularly in the field of 'activity based costing'. It is also clear 'main' is not a relative word but points to the understanding that when this term 'main' is used it reflects an existing sub-account. This is not merely stating an accounting principle but distinctively claims establishing a sub-account from a main account suitable for billing purposes (reading it in view of the specification). In short, to avoid infringement, the boundary is drawn the minute a sub-account is setup from a main account normally used for billing. Therefore, even if there are many 'main' accounts which in the view of the examiner is indefinite but the test lies whether these main accounts are for billing purposes and hence used to create a sub-account for funds payment separately which is then definite. The definiteness requirement is intended to prevent a "zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims." United Carbon Co. v. Binney & Smith Co., 317 U.S. 228, 236 (1942).

Here as in the specification, only two accounts are taught being telecommunication account and sub-accounts of the former. And as can be read from specification, the word 'main' is only used when in referencing or in view of a sub-account otherwise telecommunication account is used. This means the word 'main' certainly has an implied importance (primary) in compare to sub-account (secondary). In the case where customers do not have any sub-account then there is no need to refer to it as main account as there is no other account, so we refer it to telecommunication account.

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For example as described in Specification at page 20 and we quote "FIG. 4 is a flow chart
illustrating methods for establishing the sub account with the carrier. This application is
required in order to activate the customer 70 's sub account with the carrier by associating
this account with their main telecommunication account."

Similarly, in specification at page 12 we define what a sub-account is and Applicant
quote " The sub account is a "virtual" account separating entries between real
telecommunication cost and other transactions as authorised by the payer under terms
with the service provider and is consolidated with the <u>main telecommunication account</u>
for billing purposes. The telecommunication service provider may provide limits on this
sub account."

At the very minimum based on the above, one skilled in the art will know that main
telecommunication account is used for billing which narrows it down to a monetary type
of account. It is not known in the telecommunication art to have many type of accounts
capable of being billed and the examiner did not show how one skilled in the art of
accounting would not fairly understood this.

As mentioned, even if this is insufficient then one skilled in the art could rely on
dictionary meaning of 'main' as stated here for clarity. The Federal Circuit held in
Gargoyles Inc v United States (28 USPQ 2d 1715 (Fed Cir 1993)) that the term should
carry its ordinary meaning.

The one skilled in the art will then have to ask what is the principal or primary or
principal or most important account for a telecommunication service provider. As
mentioned, there are only TWO type of accounts (sub and main) in specification and
main is only use in view of sub-account to denote the existence of the latter else it is clear
its telecommunication account.

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Finally, even if none of the above explanation could make the word 'main' definite, then one can simply give it no weight as the word by itself does not render the whole claimed subject matter indefinite. Therefore, we respectfully submit that the examiner holding that 'main' is treated as "accounts associated with the transaction for the payee and for the payer" is in error. (See Action Letter page 3) as it totally ignores our disclosure which requires a separation between accounts for payment (sub-accounts) and main account. See, Reiffin v. Microsoft Corp., 214 F.3d 1342, 1348 (Fed. Cir. 2000) (Calling into question the so-called "omitted elements test."). In particular, the requirement to setup these sub-accounts to be linked to telecommunication account in claim 1. By omitting these elements for examination purpose, the examiner has reconstructed our claimed invention into what it is not. If telecommunication accounts could be used for payment then why do we need to setup these sub-accounts ? The specification as a whole must be considered in determining whether the scope of enablement provided by the specification is commensurate with the scope of the claims. In re Moore, supra at 1047, 439 F.2d at 1235, 169 USPQ at 238-39.

The Applicant also wish to take note that since the words 'main' was an original filling, this issue of 112 should have been brought in during First Action whereby the Applicant could properly define the matter in specification where required. By alerting this issue at the close of the examination seems to be an after thought which leaves the Applicant without any choices other than to submit a fee for further examination.

If the examiner is referring to the word 'main processor' is well known in the art for example,

In http://www.uspto.gov/go/classification/uspc711/defs711.htm, and we quote below (emphasis ours) :

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710, Electrical Computers And Digital Data Processing Systems: Input/Output, subclasses 1+ for transferring data from one or more peripherals to one or more computers for the latter to process, store, or further transfer or for transferring data from the computers to the peripherals, particularly subclasses 22+ for direct memory access (DMA) (i.e., the transferring of data between peripherals and memories of a computer or digital data processing system with minimal or no intervention from the main processor of the computer or digital data processing system).

Non-Functional Descriptive Matter as per page 6 Action Letter.

The examiner did not reason how 'telecommunication' is considered non-functional descriptive matter and as such conclusory. The *The American Heritage® Dictionary of the English Language, Fourth Edition* defines telecommunication as

1. The science and technology of communication at a distance by electronic transmission of impulses, as by telegraph, cable, telephone, radio, or television. Often used in the plural with a singular verb: *Telecommunications is an important area of professional growth.*
2. The electronic systems used in transmitting messages, as by telegraph, cable, telephone, radio, or television. Often used in the plural with a plural verb: *Telecommunications were disrupted by the brownout.*
3. A message so transmitted

The examiner had mischaracterized 'telecommunication' as a descriptive matter and concluded that it is non-functional. A descriptive matter is certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such

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descriptive material alone does not impart functionality either to the data as so structured, or to the computer. (See MPEP 2106).

The examiner provided no authority for this conclusion.

However the often cited authority is Re Gulack (703 F.2d 1381, 217 USPQ 401 (Fed Cir 1983) stating "where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability ". This principle was restated from Re Miller, 418 F.2d 1392, 164 USPQ 46 being used to advance the Board's decision. Miller involved an appeal from the board's affirmance of the rejection of claims drawn to a measuring device for use in fractioning recipes. No statutory ground for the rejection was specified. The rejection in Miller was on the basis that the invention lacked "the required cooperative structural relationship necessary before the printed matter can be given patentable weight." Id at 1395, 164 USPQ at 48. In fact in Miller, functionality was found for the applicant but only after defining functionality of the precise type found by the CCPA in Miller involving to size or to type of substrate, or conveying information about substrate. However, in Re Gulack, the majority has stated that such precise functional relationship is not required.

Pertinent in Re Gulack, the Patent Office rejected the claims as obvious in view of the prior art, reasoning there was no functional relationship between the printed digits and the band supporting the digits. On appeal which is the subject of the cited case, the Federal Circuit reversed stating as follows:

"Differences between an invention and the prior art cited against it cannot be ignored merely because those differences resides in the content of the printed matter. Under 103, the board cannot dissect a claim, excise the printed matter from it, and declared the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole. "

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The Federal Circuit also noted that printed matter may well constitute structural limitations on which patentability can be predicated (id, 217 USPQ at 403)

In addition, the Court stated a general rule as to when printed matter will be afforded weight:

"What is required is the existence of differences between the appealed claims and the prior art sufficient to established patentability. The bare presence or absence of a specific functional relationship, without further analysis is not dispositive of obviousness. (id, at 404)"

In our case, as we mentioned, the examiner expressly state the non functioning descriptive data to be telecommunication from telecommunications service provider. However, the examiner did not identify the 'substrate' in view of Re Gulack which is an endless band. In fact, the examiner provided no reason. Hence there is really no prima facie case to answer.

Even if there is a prima facie case, Applicant respectfully disagree with this mischaracterization, as the term "telecommunication" is used to qualify and modify "service provider's main processor". The main processor element is an article of manufacture having structure being operated by specifically telecommunication service provider's computer not ISP. Therefore, the recited element requires a telecommunication service provider's main processor and not as suggested an ISP service provider's main processor. It is well known that a telecommunication service provider's computer system is different to an ISP's or Postal Service Provider or Hotel Service Provider etc (as example). In fact, the entire disclosure made it clear that this claimed element of a telecommunication service provider is crystal clear and necessary. See for example Gentry Gallery, 134 F.3d at 1479, 45 U.S.P.Q.2D (BNA) at 1503 considers the situation

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where the patent's disclosure makes crystal clear that a particular (i.e., narrow) understanding of a claim term is an "essential element of [the inventor's] invention." Id., 45 U.S.P.Q.2D (BNA) at 1503. The Applicant submits that by equating to 'service provider' it could even be indefinite as it will be impossible to answer who is the service provider given there are so many types and unknown in the future. Secondly, in general, a preamble limits the claimed invention if it recites essential structure or steps, or if it is "necessary to give life, meaning, and vitality" to the claim. Catalina Mktg., 289 F.3d at 808, 62 USPQ2d at 1784 (quoting Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999)). In the instance claim 1, telecommunication service provider is a structure limitation and is recited in the pre-amble and it is necessary to give life, meaning and vitality of the claim. By omitted 'telecommunication', the meaning of the claimed invention is lost as it could be any type of service provider which is not the case claimed.

Furthermore, there is nothing in the specification that attempts to broaden the term "telecommunication service provider" to ISP or general service provider as suggested by the examiner, hence inconsistent with applicant's disclosure. Varied use of a disputed term in the written description demonstrates the breadth of the term rather than providing a limited definition. See, e.g., Enercon GMbH v. International Trade Comm'n, 151 F.3d 1376, 1385, 47 U.S.P.Q.2D (BNA) 1725, 1731-32 (Fed. Cir. 1998)

Also note that 'telecommunication' is also found in the term 'telecommunication account' found in the same claim 1 including such account is one 'non prepaid'. The Action Letter made no mention whether this 'telecommunication' within this context is also Non-Functional Descriptive Matter. If the unstated position is taken by the examiner to be Non-Functional Descriptive Matter, then no reason is shown. In re Moore 58 CCPA 1042, 1046, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (1971), with regard to a rejection under the second paragraph of 35 USC 112, the subject matter set out in the claims must

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be presumed, in the absence of evidence to the contrary, to be that which the applicant

regards as his invention.

Finally recapping on Re Gulack, in a footnote, the same court expressed some impatience

with the use of the printed matter doctrine as a basis for rejection under Section 103 (Id

at 403 at n.8)

Footnote 8 as reproduced below:

8 A "printed matter rejection" under § 103 stands on questionable legal and logical
footing. Standing alone, the description of an element of the invention as printed matter
tells nothing about the differences between the invention and the prior art or about
whether that invention was suggested by the prior art. A printed matter rejection is based
on case law antedating the 1952 patent act, employing a point of novelty approach. In re
Sterling, 70 F.2d 910, 21 USPQ 519 (CCPA 1934). The 1952 act legislatively revised
that approach through its requirement that the claim be viewed as a whole in determining
obviousness. Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). The CCPA
has considered *all* of the limitations of the claims including the printed matter limitations,
in determining whether the invention would have been obvious. See In re Royka, 490
F.2d 981, 180 USPQ 580 (CCPA 1974); In re Cavrich, 451 F.2d 1091, 172 USPQ 121
(CCPA 1971). In Royka, 490 F.2d at 985, 180 USPQ at 583, the CCPA, notably weary of
reiterating this point, clearly stated that printed matter may well constitute structural
limitations upon which patentability can be predicated.

In summary, we respectfully reject the examiner's determination under various 35 USC

112 by importing 'unreasoned' limitations as converting our claim subject matter to

something it is not for the sake of examination.

Equating Telephone to communication device & giving no patentability for "wireless" for
examination.

At page 6 of Action Letter, it is stated that a telephone was equated to a communication

device for examination purposes. The examiner asserted that because the word 'wireless'

was not incorporated in the body of the claim. While it is true that wireless was not

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recited in the body of the claim, this does not give the examiner liberty to use a 'non wireless' communication device that was not found in the specification either. "It is well settled that if the body of the claim sets out the complete invention, and the preamble is not necessary to give life, meaning and vitality to the claim, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation." Schumer v. Lab. Computer Sys., Inc., 308 F.3d 1304, 1310, 64 USPQ2d 1832, 1837 (Fed. Cir. 2002) (citations and internal quotation marks omitted). The examiner cited Re Hirao (1976) and Kropa v Robie (1951) as the authorities. The Applicant had examined these legal cases and respectfully submits that the examiner has improperly applied Re Hirao. (Since Hirao cites from Kropa v Robie, there is no need to examine latter case in detail) According to MPEP 2144.04 (Version 2, 2004) "if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court....If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection." In Re Hirao, the invention involves a process of sweetening foods and drinks. The Applicant submits that the facts in Re Hirao are not sufficiently similar to the present application. The question in Re Hirao is whether certain words found in preamble is held to no patentable weight where it merely recites the purpose of a process or the intended use of a structure, AND where the body of the claim does not depend in the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. In Re Hirao, the questionable words from the preamble recites "process for preparing foods and drinks sweetened mildly," is held to be intended use. However, in the instance claim, there is no similarity since 'method for payment or fund transfer' has nothing to do with food and even if this is held to be intended use, the same cannot be said of the word 'wireless'as asserted by the examiner. Furthermore, the examiner is questioning "wireless communication device" which is a structural limitation. Note that in Claim 1 preamble, it includes the word "USING" said limitations. The word USING could not be said intended use as it has to be USING said recited limitations. Furthermore, it could not be

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said that a wireless communication device is not needed in view of the body of the claim given that the element " sending at least a password by payer over said second network" requires a device for sending in view of the specification.

As noted in our specification, at least one of the network is taught to be wireless, therefore the claimed invention at claim 1 (body) which includes this element "second network" must be used to explain the limitation of 'wireless' without which the invention is not complete. In short, one skilled in the art will ask what kind of second network is this hence will read the specification to determine the scope of claim 1 as explained which happens to be wireless hence supporting for a wireless communication device. However, "limitations appearing in the specification will not be read into claims, and . . . interpreting what is meant by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.'" Intervet Am., Inc. v. Kee-Vet Labs., Inc., 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989). In this case, it is clear that the specification provides an interpretation or explanation on how to practice this second network. Alternatively the specification only details two networks whereby one of them is used by a wireless communication device, then accordingly this "wireless" could not merely be an intended use as suggested by the examiner but forms the claimed invention. Moreover, in general, a preamble limits the claimed invention if it recites essential structure or steps, or if it is "necessary to give life, meaning, and vitality" to the claim. Catalina Mktg., 289 F.3d at 808, 62 USPQ2d at 1784 (quoting Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999)). A wireless communication device is certainly an essential structure.

"Whether a preamble stating the purpose and context of the invention constitutes a limitation of the claimed process is determined on the facts of each case in light of the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history." Applied Materials, Inc. v. Advanced

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Semiconductor Materials Am., Inc., 98 F.3d 1563, 1572-73, 40 USPQ2d 1481, 1488 (Fed. Cir. 1996). Therefore, the examiner must consider the form of the claim, the claimed invention as described etc and could not conclude that because 'wireless' is not found in the body of the claim this is sufficient to be intended use only and gives little patentability weight when the specification explicitly teach using a wireless network and wireless device. As far as the prosecution history is concerned, claim 1 as originally filed includes this wireless communication device. The Applicant submits that the examiner had not discharge or show any determination on the facts here to merit his conclusion.

Even if the examiner is correct, it makes no sense to only give "wireless" no patentability weight while maintaining "communication device" by equating it to telephone. If the wireless communication device is not essential then it must be the whole device and not merely a feature of the device which is ignored. Since the examiner applied Re Hirao incorrectly, the Applicant respectfully submits that wireless communication device as a whole must be given patentability weight.

Rejection under 103(a).

All elements must be taught or suggested.

The examiner still fail to establish that all claims limitations are taught or suggested. In providing the explanation of where the claims limitations are taught by the prior arts, the examiner has erred by misinterpreting the claims in the present claimed invention by importing various assumptions which are unsupported. For example :

1. For examination purposes, the service provided is equated to billing platform and the steps extending, establishing, sending, an ISP with an authentication service performs authenticating. (At page 3 of Action Letter)

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2. For examination purposes the word "main" will be treated as accounts associated with the transaction for the payee and for the payer. (At page 3)

3. In addition, the telecommunication service provider was equated to a service provider and citing the telecommunication is considered to be non-functional descriptive- little weight (At page 6).

As we have mentioned and objected strongly such liberal interpretation even if accepted must be within the Applicant's disclosure otherwise it is only self-serving to reject this application. For example in Point 1 above, ISP was used but nowhere did the Applicant suggest ISP and how ISP was arrived is not shown or reasoned by the examiner.

For example, in Point 2, the examiner had impermissibly allow himself to treat the main telecommunication accounts as payment accounts which is contrary to the teaching of the disclosure where only the sub-accounts are for this purpose.

In Point 3, telecommunication was asserted to be non-functional and yet the examiner fails to show how this is non-functional. Such conclusion is not prima facie. Telecommunication account is an element found in the telecommunication service provider's system and it is certainly functional being used for debit and credit entry and NOT non functioning data by itself. In effect such 'equivalency' for examination purposes changes the subject matter of the Applicant's claimed invention to something it was never intended and patently wrong. For example by removing telecommunication to a general service provider, the claims become any type of billing platform which totally ignores the significance of using telecommunication service provider as the means to affect payment (subject matter as a whole).

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<u>Referring to element two of Claim 1</u>:

extending at least one the telecommunication service provider's main processor for establishing sub accounts for both payer and payee on the provider's main processor having a corresponding account identifier to the main telecommunication account;

The examiner provided Abstract, Col 4, lines 38-46 and Fig 1. The Abstract in Woodhill shows nothing in terms of establishing sub-accounts nor its application in user to user payment as limited by the words "payer and payee". Col 4 line 38-46 repeats its authentication, authorization for electronic transaction between a network (Internet) and PSTN. Fig 1 of Woodhill generally shows the system layout inline with Col 4 line 38-46 of Woodhill specification.

Firstly, the Woodhill patent (provisional filed Dec 15, 1999) relates to authentication users wishing to use a service such as an online transaction including collection of payment information (credit card) (Col 5 line 54) but nowhere does it suggest or teach <u>telecommunication accounts</u> information for payment purposes. In fact Woodhill's main subject matter is on authenticating Site Visitor (See all figs). Even if this was equated for examination to payer and payee accounts, these limitations are still not found in Woodhill. For example, these payee and payer sub accounts are established on main processor with corresponding main account which denotes there are TWO separate type of accounts as a result.

The Woodhill patent also did not suggest extending main processor to establish sub-accounts having corresponding identifiers to the <u>main</u> telecommunication account. As earlier questioned by examiner, who is extending main processor ? It is obvious since the main processor is the property of the telecommunication service provider, it is only natural to assume any work done here must be by service provider on instructions by user

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(Fig 4 of our Application). As mentioned, the applicant could not see why after setting up sub-accounts for payer and payee the examiner could later suggest equating the main accounts to be the same which not only contradicts our disclosure but patently ignores our discussion on separating the two. Even if 'main' is discounted, the examiner did not provide any explanation how this two different type of accounts are same.

Referring to the third element of Claim 1 as below:

receiving the payer's telecommunication account identifier, the transfer amount, the payee's telecommunication account identifier upon initiation of a transaction over a first network;

The examiner provided Col 4, lines 56-67 and Col 5 lines 1-54. In this respect, Col 4 lines 56-67 details where a site visitor is presenting his credentials or specific phone number to the server and the authentication software transmit specific confirmation information in response. For Col 5 line 1-54 it details how the site visitor receiving a call and ask to input specific information back via a phone (second network). It also describe the advantages of using a voice response to confirm information back etc and collection of payment information (eg credit card information (see col 5 line 54)). Note that this element requires the server or in the instance case the payment processor to receive "something" through a FIRST network from payer.

Considering Col 4 lines 56-67, the Applicant assumes the examiner is showing that when user presents his credential or specific phone number would inherently shows our payer's telecommunication account identifier, the transfer amount, the payee's telecommunication account. Even if this is to be accepted, there is nothing to show transfer amount and payee's telecommunication account through First Network. As to the teaching of transmit specific confirmation information, this is done by server in Woodhill (not payer) so it does not show our element. As to input said information in Col 5 line 1-

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54, this does not inherently shows our element of network one since as mentioned Woodhill only teach said information are provided by user through Network TWO.

Here our claimed elements clearly shows these information are user's own using first network ONLY. Therefore, even if these specific confirmation information is the same as our information, said specific confirmation information as taught by Woodhill cannot reach any of our said element as they must be return through SECOND network as taught by Woodhill as compared to our FIRST network as claimed.

Even if payment amount is inherently shown by Woodhill at Col 21 line 63 to line 67 and Col 22 line 38-60 (see Authorization System) which teaches some relationship with charging a credit card, there is no teaching of providing payee's information. It is not known in the art of paying an online merchant (payee) to provide their account by payer. For example if this is a merchant website connected to a credit provider say VISA, then the user provides his VISA data, amount BUT not the merchant's information (payee data).

It is well known in the art that VISA credit card number is secret to others (but not telephone numbers). More significantly, given that because telecommunication identifier is NOT a secret as compared to credit card numbers, this is precisely why in our claimed invention requires the payer to send a password through a second network (see next step). In other words, if a telecommunication identifier is used in lieu of secret credit card number, in theory the user could simply put his charge on anyone's telecommunication identifier without a way to evidence its authorization which makes Woodhill's teaching of using telecommunication identifier unsound.

Woodhill (at Col 21 line 63 to line 67 and Col 22 line 38-60 (see Authorization System) expressly did not teach this in its authorization system which is basically a combination of authentication and to charge a credit card. The system as stated by Woodhill, is

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concerned with identifying the user at the terminal with a phone and once its authentication is done, password and ID are send via first network and this will allow user to provide a credit card to do the authorization step. Therefore, it is clear without some teaching to evidence authorization (such as able to send a password linked to telecommunication identifier sub-account via a second network) in connection to non-secret telecommunication identifier, Woodhill's invention is limited to financial cards only. This is clear as to date there is no requirement for presenting a password with a credit card to effect a payment.

<u>Referring to element 5</u>

sending at least a password by payer over said second network;

The examiner at page 5 charges the Applicant that Woodhill shows this by citing Col 2, line 33 and Col 4, lines 47-55.

Col 2, line 33 is "A "something you know" is a piece of information which alone, or taken in combination with other pieces of information, should be known only by the entity in question or those whom the entity in question should trust. Examples are a password, mother's maiden name, account number, PIN, etc. This type of authentication factor is also referred to as a "shared secret". " (For completeness, the Applicant had copied the entire paragraph rather than extracting out of context).

This paragraph actually teach of about "something you know" one of the authentication method known in the art. The applicant accepts this because password and its usage is old in the art. The only issue left is whether such password is transmitted through a SECOND network by PAYER in Woodhill ?

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Col 4, lines 47-55 shows "This coordination of an active Internet session with an active PSTN session can be used as a tool for <u>verification</u>. In one embodiment, it can be used to create an audit trait for any individual electronic transaction. These transactions may be, for example, <u>the first-time issuance</u> of an electronic security credential (e.g., passwords, digital certificates, PINs) or the <u>verification of a security credential already issued</u>. Other transactions, without limitation, come within the spirit and scope of the present invention."

This paragraph teach how coordinating Internet session and PSTN (2 networks) is used for verification and provide two possible transaction being "first time issuance of an electronic security credential" or "verification of a security credential already issued" as stated above (see underlined). To better understand this, one has to consider Woodhill's teaching of the two so the Applicant will start with <u>First Time Issuance first</u> which is detailed in Fig 3 of Woodhill titled "Registration" and in Col 4 line 56 to Col 5 line 6 and in Table III.

<u>A) First time issuance of an electronic security credential</u>

Woodhill's method could be summarised as follows: Visitor access website and request access. Provides a phone number (credential) and system returns a conformation information to screen via first network with instructions to provide same via second network. Connect second network and receives conformation information from user for comparison. If comparison is ok then send PWD and ID via first network by system and registered user. (See Table III)

<u>In particular, no password is SEND at this stage by the payer through a second network.</u> Woodhill teach that "The site visitor, on receipt of the call from the software, is requested to key in via phone pad or to read back the <u>confirmation information</u> via the telephone network". This confirmation information could not be a password and the examiner

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placed no reason to show that it must necessarily be. As stated by Woodhill, at Col 4 line 62-65 " Authentication/authorization software can at this time transmit specific confirmation information to the user's display. This is information available only to the transmitting software and the recipient." Confirmation Information is defined in item 8 of Table III or see Fig 9 of Woodhill. More importantly this information is send via first network so effectively it does not satisfied our limit of second network.

As to password, this NEW password is then PROVIDED by the system to the user via the first network. (See Table III item 13 and Fig 10) Note that under PSTN session in Table III item 13, the visitor receives the following message "Congratulations, you have completed your authentification. Your new userid and password displayed on your computer screen. Good-bye." This must means the NEW password is sent through first network under Internet Session as it is displayed on computer screen. This clearly shows it is not via second network and said password is UNKNOWN to user until authentication is completed.

B) Verification of a security credential already issued

The Applicant turns to the second stage where the visitor is presenting his credentials for accessing a site. This is illustrated in Table III item 14 which explicitly shows NO PSTN session and only Internet session for user to enter his password and userID. If this is not then nowhere did Woodhill show this method of verifying security credential already issued. At best this will be obvious to try which is not the standard for obviousness rejection.

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Comparison of the two methods.

Woodhill- Authentication System	Claimed Invention
Authentication Stage	Authentication Stage
1. Providing credential. In response instructions for transmitting confirmatory information, via the first network, to the first terminal. (Internet)	Normally this is done when user purchase a mobile phone which is done at a regular shop where they take the user's identification details and provide a phone number.
2. Instructions for receiving a representation of the confirmatory information, via the second network, from the second terminal. (PSTN)	Having a phone number, user then create a sub-account with telecommunication provider (Fig 4) which is over ONE network.
Accessing Website Stage.	Payment Transaction Stage
3. Sending Password and ID to user by system to access Website through first network (Internet)	There is no need to send any Password and ID since the password was provided by user at time of setting up sub account.
4. User using Password and ID to access Website through first network. (Internet)	Providing information for payment (payer, payee, amount) through first network (Internet)

Providing payer's password through second network (PSTN). |

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As noted In Loral Fairchild Corp. v. Sony Electronics Corp., 181 F.3d 1313, 1321, 50 USPQ2d 1865, 1870 (Fed. Cir. 1999), the claim language itself indicated that the steps had to be performed in their written order. See also Mantech Envtl. Corp. v. Hudson Envtl. Servs., Inc., 152 F.3d 1368, 1375-76, 47 USPQ2d 1732, 1739 (Fed. Cir. 1998) (holding that the steps of a method claim had to be performed in their written order because each subsequent step referenced something logically indicating the prior step had been performed). The above methods clearly shows that Woodhill only suggest the Password and ID are provided after authentication had occurred through First Network. The authentication requires the sending of confirmation information to user's display through First Network and whereby the user responds by providing confirmation information through Second network. This is in contrast with our method of providing payment information (payer, payee, amt) through First Network and password through Second Network. The examiner did not explain how the steps order are different and in effect failed to show password being send via Second Network by payer.

Why confirmation information send via second network is not password.

In effect, even if confirmatory information in Woodhill is capable of including a ****PASSWORD****, where this is generated by the system to the first terminal via first network and re-submit via second network, the applicant respectfully submits that this is unsound as confirmation information as applied at this stage is to test whether the user could be authenticated. Therefore, while the user is being tested for authentication, it is technically unsound to send him the password at this stage when the testing is still being conducted.

In short, this information must be UNKNOWN to user until displayed on data terminal unlike our claimed password which is KNOWN to the user given it is the user who provide this via a first network at the time of setting up sub-account (Fig 4 of claimed invention) as per this claimed invention. This is not a minor technical point as it clearly

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illustrates the difference between authenticating a visitor without any prior credential and authenticating a payment transaction where the (authorized) user has set-up a sub-account linked to said password. In re Chu, 66 F.3d 292, 298, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995) (stating that even when changes from the prior art are "minor" or "simple," an inquiry must be made as to whether "'the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes'" (quoting Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 935, 15 USPQ2d 1321, 1324 (Fed. Cir. 1990))).

The critical difference between Woodhill and our claimed subject matter as a whole is that our user establishes a sub-account on his own initiative wherein a password is provided by said user. Because the user already has a telecommunication account at the time of purchasing a mobile phone, this step requires no authentication of the user as it is assume the owner of the mobile phone number is the same user that is setting up an account. There is no danger of any mischief since the mobile phone is needed for sending the password for confirmation for transfer of funds. In contrast with Woodhill, authentication is sought first because the web-service provider has NO information about the user at the point of sale (website). In response to presented credential, and only after confirmation information is send through first network and resubmit through second network (PSTN) then a password and ID send over first network. In fact this whole exercise is needed in Woodhill because Woodhill does not use a telecommunication account otherwise by merely presenting the telecommunication identifier, the user could be authenticated immediately by reading the records as in our disclosure. Woodhill made no issue about using telecommunication account for payment and was only interested in authenticating user at point of sale (web-site). This could be problematic as an illegal user could potentially use another user's terminal and telephone to make a purchase when the legal user's terminal and phone are left unattended. In our instance case, there is no danger for this as the illegal user could not have known the password required even if both terminal and mobile phone are within illegal user's control. As the applicant has mentioned, this password is provided by the user at time of set-up sub-account and NOT

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the system as in Woodhill being displayed after authentication. Therefore, the critical element is the step of providing a password through a second network which is not taught by Woodhill following initialization of a transaction.

It is also pertinent to note that Woodhill at Col 21 line 63 to line 67 and Col 22 line 38-60 teaches some relationship with charging a credit type facility (AUTHORIZATION as compared to AUTHENTICATION previously). For clarity, the Applicant has produced the entire teaching and quoted as follows : " An exemplary authorization system in accordance herewith includes, first and second electronic networks which are, at least in part, different. First and second terminals, with each terminal associated with a respective network. Instructions for receiving an inquiry from the first terminal, via the first network. Instructions for establishing an address of the second terminal on the second network. Instructions for establishing a communications link, on the second network, with the second terminal. Instructions for transmitting confirmatory information, via the first network, to the first terminal. Instructions for receiving a representation of the confirmatory information, via the second network, from the second terminal. Instructions for comparing the received representation to the transmitted information and for producing a comparison indicating indicia. Instructions responsive to the comparison indicium for conducting an authorization process and for generating an authorization related indicium; for authorizing a charge to a financial account wherein the inquiry from the first terminal includes a financial account designator, wherein the instructions for conducting an authorization process include instructions for evaluating if a proposed charge to the designated account will be accepted, and, for authorizing a charge to a credit-type account wherein the instructions for evaluating comprise instructions for determining if a proposed charge to a designated credit-type account will be accepted as an increase to an amount due on the respective account. "

Note that the payment stage comes after the "instructions for comparing the received representation to the transmitted information and for producing a comparison indicating

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indicia". This translates to receiving a signal that said comparison is OK and user is authenticated. If we refer to Table III again, this will either be through network one or two and normally the user at this stage will receive a user ID and password displayed at terminal one via network one. (See Table III item 13). However as this is for a payment, the display will now show instructions to conduct an authorization process. The user in Woodhill will then provides a financial account designator from first terminal via first network (Internet).

Therefore again, even if payment is teach by Woodhill, <u>it does not teach that a password known to the user is send through a second network after authentication</u>. Apparently, Woodhill is not concerned about authenticating the transaction after authenticating the user. This may be so when financial cards such as credit card is used since the data is secret but not so for telecommunication identifiers say phone numbers are well known. Hence it is clear Woodhill did not address this feature by adding a need for a password send over a second network. <u>It is also not known that by presenting credit data to couple with a password in the art.</u>

If we consider this teaching against claim 1 as a whole, it is certainly not complete given Woodhill taught of using a financial account (credit type) and not a telecommunication account. It is also not a payment processor "middleman" as it suggested conducting authorization process usually found at credit service provider. A "middleman" processor could process multiple issuers' cards like a gateway which directs the actual authorization to the respective entities. A payment processor by itself could not make a determination whether to accept or reject as it is merely a gateway network to the actual processors (VISA or Mastercard).

Therefore even if there is a second authentication found in Woodhill (there is no teaching for this and it is questionable why it is necessary) this will still not reach our claim for 'sending at least a password by payer over said second network' as asserted by the

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examiner. As mentioned, the fundamental concept of Woodhill is to generate a confirmation information through network one and ask user to resubmit through network two. This is significantly different in view of our claimed limitation for providing a password and this password is already known to the user as contrast from confirmation information is not known at all to user. If it is already known to user then why is there a need for system to generate and send to user via network one ?

Referring to element 6 :

authenticating said respective account identifiers and said password linked to the sub-account of payer ;

The examiner provided Col 6, lines 36-51 and lines 57 –65

Our reading of lines 36-51 shows that Woodhill teach a transaction record of an authentication session and line 57-65 deals with communication between a target site and authentication service. While we acknowledge that authentication is taught by Woodhill, however, there is nothing that suggest that authentication is for the sub-account of payer/payee whereby said sub-account is linked to password for payer.

As mentioned, payee is unknown in Woodhill and sub-account is also unknown as Woodhill never show establishing them. Even if it is well known that authentication must include a password and identifier, it is not well known to authenticate a sub-account since the latter is unknown in the art. It should also be noted that with reference to password, Woodhill actually taught issuing the password after authentication is completed (first time issuance) by the system (See Table III item 13 and Col 4 line 51 of Woodhill) in contrast to our user provide password linked to the sub-account (Fig 4). So the difference here is that Woodhill's password is generated by the system as compare to provided by user at the time of setting up sub-account. The examiner provided no

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motivation to modify and as mentioned, if it is a user provided password then what reason is there for the system to send it over a first network given the user would already know the password ?

Referring to element 7

whereby said authentication is satisfied, includes a further step of recording a debit entry for said transfer amount in payer's sub-account and a credit entry for same for payee's sub-account;

The examiner did not provide any reference here for the above and instead group the next element "wherein payer's telecommunication account is a non prepaid account" by suggesting the applicant to see Col 8 lines 52-65 and Table III, item 12.

At Col 8 lines 52-65 and we quote in full as "Assuming that the appropriate confirmation information has been fed back by the visitor V to the server **38** using the network **44**, the server **38** can direct the visitor V to terminate the telephone call. The server **38** can then compare the received confirmation information to the transmitting confirmation and determine if they are the same. Control of the visitor's browser can then be returned to target site **30** along with a message confirming the identify of the visitor V or providing authorization information in connection with a transaction based on initial information stored in data base D of server **38**. Either one alone or both of servers **38** and site **30** can be involved in making the authentication/authorization decision. The site **30** then continues the transaction and communicates directly with a visitor V. "

We respectfully submit that the above show nothing about debit or credit payer and payee respectfully, nor their sub-accounts. As mentioned, Woodhill was mainly concerned about site visitor and authenticating said. As alluded previously at Col 21 line 63 to line 67 and Col 22 line 38-60 of Woodhill, there is suggestion of a credit type transaction but

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this does not mean a credit and debit is recorded. In fact it merely cause an authorization process and waits for a response similar to typical website connected to VISA for approval. No mentioned of non-prepaid account is found in Woodhill and obviously a financial account is NOT a telecommunication account.

Table III item 12 reads into authentication steps. In particular, the table is headed "Immediate Synchronization" and is divided into 3 columns which we have reproduced below for clarity.

Internet Session	PSTN Session	Comments
The same web page as step 11 (fig 10)	Server 38 will instruct the site visitor to record his/her acceptance of the terms an conditions: "XYZ Corporation now needs to record your acceptance of the terms and conditions from its web site. After the tone, please say 'I accept the the conditions', then press pound."	Again, this recording is intended to be used as an audit an trail mechanism. The owner of site 30' can determine if it would like this voice recording or any additional recordings. The owner of site 30' decides if the Server 38' should use speech recognition to verify proper acceptance or use number entry (e.g. "Press 1 if you accept, 2 if you do not") as an alternative.

The applicant respectfully submits that at best the above shows authentication method (See fig 10 where the browser is asking the user to listen carefully to the phone) but not about debit or credit or non-prepaid accounts. If recording his/her acceptance is debit and credit then the Applicant respectfully ask the examiner to show evidence on reaching this conclusion.

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In summary a list of the elements not found in Woodhill can be found in the table below:

Claimed Method	Woodhill
extending at least one the telecommunication service provider's main processor for establishing sub accounts for both payer and payee on the provider's main processor having a corresponding account identifier to the main telecommunication account	extending is not found. payer and payee is not found. establishing sub-accounts are not found. telecommunication account is not found.
receiving the payer's telecommunication account identifier, the transfer amount, the payee's telecommunication account identifier upon initiation of a transaction over a first network;	receiving payee's telecommunication account identifier is not found.
establishing a connection with payer for authentication over a second network different as compared to the first network;	ok
sending at least a password by payer over said second network;	No, only confirmation information is send via network 2 after being read from display connected via network 1. Password and ID is only send through network 1 by system (See extensive discussion above)
authenticating said respective account identifiers and said password linked to the sub-account of payer;	authenticating payee's identifier is not found (note it has to authenticate respective account identifiers which means one of them is payee's). While password is found this is generated by system and not user provided linked to sub-account.
whereby said authentication is satisfied, includes a further step of recording a debit entry for said transfer amount in payer's sub account and a credit entry for same for payee's sub account; and	only show authentication but nothing on recording debit or credit of payee or payer sub accounts, transfer amount.

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wherein payer's telecommunication account is a non prepaid account.	Not found, Woodhill shows financial account (not telecommunication) and it is credit type (not non-prepaid). It is not known for telecommunication account to charge credit on usage.

Evidence of sub-accounts.

At this juncture, it is pertinent to examine the state of the art. For instance Katz (US 6424706 and filed March 31, 1999) stated (Col 6 line 65-Col 7 line 3) "In a preferred embodiment, the unit-minute method and system of the invention is integrated with a telecommunication-switch that enables subscribers to access their unit-minute account using any telephone." Also see Katz Col 9 line 5-25, the strongest evidence showing there are NO sub-accounts reads: "For instance, in a preferred embodiment, the present invention leverages existing prepaid minute accounts stored within a prepaid telephone platform, rather than replacing them with the invention's own minute accounts. Therefore, in order to perform the necessary unit-minute transactions, the unit-minute system must have read and write access to these accounts, and a converter for converting the existing prepaid minutes of the prepaid platform to the unit-minutes of the invention." (emphasis ours)

Payment Processor

The Action Letter also stated that Woodhill provides for a payment processor (at page 6) but failed to teach linking to the networks. We respectfully submit this is in error as an authorization system (see Col 21 line 63 to line 67 and Col 22 line 38-60 of Woodhill) is not the same as payment processor. A word search on the entire patent reveals the word 'payment' only once at Col 5 Line 53 and this relates to collection of payment

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information. There is no evidence shown by the examiner to reveal the mere collection of such information must necessarily shows payment processor given the entire patent's subject matter is on authentication of user visiting a site (See All figs) and NOT payment (a payment processor directs other telecommunication service provider machines to record credit and debit entries in their respective sub-accounts). It also acts as a complete middleman for ALL telecommunication service providers by instructing said to do debit and credit which is not apparent in Woodhill nor addressed by Woodhill. It is also not known in the user authentication art to use a 'middleman' to authenticate users. See below.
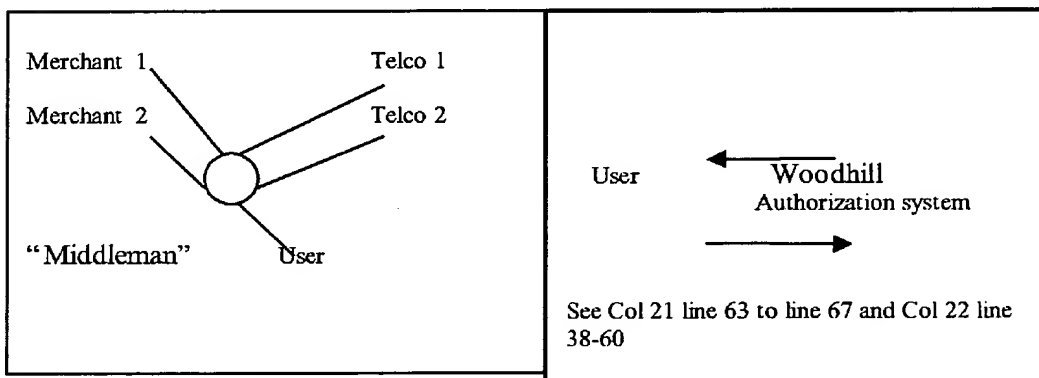
Combining with Ronen to show a centralised payment processor linked to the networks.

The examiner charges us with the knowledge that Ronen (US Pat 5845267) teaches a centralised payment processor connected and provided Abstract, Col 2 lines 55-62 and Fig 1. For clarity we have quoted Col 2 lines 55-62 as "At the conclusion of the transaction, the billing information is provided from the merchant ISP back to the Billing Platform, which bills the user's account in accordance with a predetermined billing mechanism previously established by the user and determined by the Billing Platform in accordance with one or more parameters associated with the transaction. These parameters can include the amount of the transaction, the type of transaction, and/or the

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identity of the merchant ISP. Accordingly, the user's bank credit card, the user's debit card, the user's telephone account, the user's merchant credit card associated with the merchant ISP, or any other preselected billing mechanism <u>is used to bill the user</u> for the cost of the transaction. "

It is noted that while Ronen provides for a billing platform includes both a Transaction Server and a Bill Server, the latter is relied upon for billing (see above " bills the user's account). However, our claimed centralised payment processor is linked to the network which is also linked to telecommunication service providers (See Fig 2).

At col 5 line 27, and col 8 line 8 to 10, Ronen taught the billing platform to provide credit approval which is not the same as our payment processor <u>since credit approval is sought from the telecommunication service provider</u>. Ronen is silent on whether it seeks approval from the final biller ie VISA or any of the preferred billing method. Ronen only taught billing VISA etc. This is significant as it means direct involvement in acceptance and not merely as the 'middleman' processing instructions. In short, Ronen's 'payment processor' is not processing payments, it is actually a 'credit authorizer' for the ISP Merchant and later bills the clients using their preferred billing methods. And because Ronen seeks to bill later without first seeking authorization from Billers, it may face rejection while our signal to credit or debit cannot be refused since the telco had already given authorization at the outset. One must be careful to see the different functionality here between a payment processor and credit authorizer, the former acts as a middleman by confirming transactions and the latter is directly the acceptor (ie the telecommunication service provider in our claimed invention which response by accepting or denying the transaction). Therefore, the ISP Merchant in Ronen actually depends on billing platform for their payment. Ronen's billing platform actually receives the bills from the ISP Merchant (See col 8 line 16-20 where Ronen taught of merchant ISP forwarding a bill to Transaction server) and transmit them for processing at the respective billing centers like VISA. Therefore, when VISA receives payment from

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Billing Platform on behalf of user, they may pay Billing Platform which in turn will pay the ISP Merchant. If Ronen had wanted his payment processor to work merely as a 'middleman' then it could not be the credit authorizer as by being the authorizer, it effectively becomes the bill collector and collect payment on behalf of the ISP Merchant in order to pay them. If transaction is at least pre-approved by VISA then it is possible Billing Platform plays no role other than a middleman but this is not the case here.

Therefore, the Applicant conclusion is that Woodhill did not teach a payment processor and even if Ronen teach a payment processor, Ronen's processor is actually a credit authorizer and not merely acting as a middleman.

The examiner failed to establish that the prior arts suggest the desirability of the proposed modifications.

The examiner provided the motivation to combine with Ronen as "to ensure complete tracking of the transaction, which will ensure that account of the payer, is debited and the account of the payee is credited." The examiner's rationale presumes that by able to track the transaction this will ensure the accounts are properly credited and debited. The examiner placed NO evidence on record to show that by able to track transactions this will ensure accounts are properly credited and debited. The Applicant respectfully ask for Official Notice by the examiner on this count as it is unknown (out side of our disclosure) where tracking results in accounts being properly credited and debited.

Firstly, debit and credit is done on telcos accounts and not in the payment processor. Ronen simply charged the clients by means of messages transmitted over private facilities. (Col 7 line 29-31). Sending them for billing is different to sending signals to respective telcos to debit and credit their accounts as the Applicant stated. Furthermore a bill presented can be refused especially if it is determined to be fraudulent by the card issuer. As mentioned, Ronen taught itself as the credit authorizer (we quote " obtains

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credit approval from billing platform 120" (see col 5 line 27)) which means it is possible that its authorization result could be different to the card issuer or telephone service provider when later presented by Ronen for billing. Therefore, it is clear Ronen's payment processor could not <u>instruct</u> telcos to credit and debit by teaching presenting a bill. And hence similarly, there could not be debit and credit at telcos sub account following authentication as per our claimed because authourizaton in Ronen was done by its processor and not by the billers (or telcos in our claimed) and billers can't simply take instructions from another unless such instructions were pre-approved.

The examiner did not provide any evidence from either Ronen and Woodhill where there is any teaching of debit and credit of sub-accounts. The examiner had only concluded by including the 'payment processor' to ensure tracking of the transaction which will ensure the account of payer is debited and account of the payee is credited but there is no supporting evidence found in Ronen's 'payment processor' of doing any debit and credit at all. Similarly, Woodhill teaching shows authorization system but it is not a payment processor. It is more likely a VISA authorization system type attached to authentication method as described by Woodhill and not a 'middleman' type as claimed here. Furthermore, as mentioned, claimed payment processor does not debit and credit by itself, this is actually done at telco sub-account which is not known in the prior arts. Therefore, the Applicant respectfully submits that the examiner had erred by improperly relying on hindsight reasoning which in this case is found in the Application.

Alternatively, it is not so well known to use telecommunication accounts to affect payment wherein includes sub-accounts separate from its primary telecommunication billings. (See Katz's explanation above which describe using a prepaid facility found in telecommunication account to buy time units as the currency). Also note that our claimed element includes non-prepaid accounts which is not taught by Katz. The applicant therefore respectfully submit that Claim 1, 21, 28 taken as a whole is patentable over Woodhill, Ronen and Katz.

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<u>The examiner failed to consider the 'subject matter as a whole'</u>

"In determining differences between the prior art and the claims, the question under 35 USC 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP 2141.02 (emphasis in original) (citing Stratoflex, Inc v Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed Cir. 1983); Schenck v Norton Corp., 713 F.2d 782, 218 USPQ 698 (Fed Cir 1983).

"In determining whether the invention as a whole would have been obvious under 35 USC 103, we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question....but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification.." In re Antonie, 559 F.2d 618, 620, 195 USPQ 6,8 (CCPA 1977). An inherent property of the claimed invention is the ability to act as the 'middleman' for all the telecommunication service providers with the added security of authenticating transactions over a different network whereas both Woodhill and Ronen's is an authorizer. In Ronen it actually approved the transaction and send it for billing later while Woodhill actually teach of a credit authorizer with added feature of authenticating user at the outset. Even if we factor in Ronen taught of billing telephone account, the problem with telephone number as the identifier for billing is said is known by everyone hence a need to secure this such as found in our element of sending password through a second network. Ronen simply suggest to send for billing at telco which could be problematic when the account holder dispute this item in his bill with telco and telco with Ronen's processor.

And if we applied this teaching across to Woodhill, it is still problematic as there was no teaching of providing a password through a second network to confirm such telephone

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number is indeed authorized for charging by its owner. Because Woodhill only taught financial card, like credit card which data is secret then it clearly shows Woodhill did not contemplate of using telecommunication identifiers. Therefore the absent of any teaching to conclusively evidence the authority of the payer in the transaction in the cited prior arts clearly demonstrate this issue was not known to them or considered necessary.

Ronen also totally ignores the significant of able to aggregate the sub-account with the main account for billing. For example, while Ronen simply charges the telco and the telco merely adds the charge to the client's bill, but our claimed invention includes the credit side which means a client who is receiving money from another will actually see a reduction of his 'telephone' bill since credits is being applied. This highlights the issue of 'tracking' known in accounting principle where there is a debit there must be a credit else a single entry is NOT. Ronen fails to teach this credit side of the transaction. Fundamentally because the claimed invention uses telecommunication identifier, this effectively means anyone with a number can be paid including non-merchant, something that is not recognised in Ronen and Woodhill. Woodhill taught of using a credit card which traditionally could not be used to pay non-merchant directly. While this advantage is shown in Katz (US 6424706), Katz requires a prepaid account instead of our non-prepaid accounts in claim 1. Katz also ignores the need for authentication and went so far as to suggest "transactionally safe and reliable." (Col 9 Line 25). Katz also fails to show able to provide transaction between multiple telecommunication service providers who are unrelated to each other (ie debit Telco 2 and credit Telco 1.) Traditionally, prepaid card's value could only be used on the service provided by the SAME card issuer and not across to another service provider. This means the payer and the payee must be using the same service provider as there is no way to transfer between inter-telecommunication accounts. The examiner may wish to refer to US PAT **6,805,289 by Noriega filed May 23, 2002** which post-date our application 04-09-2001.

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<u>Claims 2, 22 and 3, 23, 29 and 20, 27.</u>

With respect to the above claims which depend from Claim 1,21,28, the Applicant respectfully submits that such claims are patentable because as indicated above, Woodhill does not suggest ALL of the claim limitations of the independent claims 1, 21, 28.

<u>Referring to Claim 4, 24 and 30</u>

The examiner charged the Applicant that Ronen teaches our subject matter and pointed to Abstract and Fig 1 as evidence. As mentioned, Ronen is itself a credit authorizer (Col 5 line 25-27) but it also teaches billing the various external biller such as VISA, telephone account etc which do not show prepaid accounts. As the applicant mentioned, the method of billing does not necessarily shows debit and credit since by presenting the bill to another, the payee stands in a position of being rejected and hence could not evidence must necessarily flow from the teaching to reach debit and credit. Ronen as mentioned did not show verifying the availability of funds at the telecommunication account, Ronen merely authorize by itself. (See Col 6 lines 59 to 64 and we quote "Thus, once the Billing Server 126 affirms the user at terminal 101 as an authorized user who has pre-established a billing mechanism, Transaction Server 121 is signaled and, in turn, a message is sent to merchant ISP 115 authorizing the transaction. " In short, according to the teaching, as long as the user has pre-established billing mechanism, the transaction will be authorized without checking if any prepaid funds is available. See Col 6 line 1-10 where Ronen suggest credit and debit accounts but NO prepaid. It is not known for VISA or MasterCard to offer prepaid at the time of this invention. Even where Ronen suggests charging a telephone account, this is not the same as debit from a sub-account as defined in the specification. And even if debit is found, there is no evidence of anything teaching corresponding to credit another sub-account in Ronen. Even if debit and credit is well known in accounting art, it is not well known to do so for sub-accounts for telecommunication service providers. The examiner place no reasoning how these

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elements are meet and even a single reference requires some suggestion or a motivation

must be found to modify (B.F. Goodrich v. Aircraft Braking Sys. Corp., 72 F.3d 1577,

1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).

The Applicant respectfully ask the examiner to allows these claims for the reasons above.

Referring to Claims 5, 25 31.

The examiner charged the Applicant that Ronen teaches our subject matter and pointed to

Col 6, lines 36-51 and lines 57-65 as evidence. For clarity, the Applicant have quoted the

evidence at line 57 – 65 as follows : "record all transactions associated with that user on

the Connection ID of the present instance of communication between the user 101 and

the merchant ISP 115. Thus, once the Billing Server 126 affirms the user at terminal 101

as an authorized user who has pre-established a billing mechanism, Transaction Server

121 is signaled and, in turn, a message is sent to merchant ISP 115 authorizing the

transaction. At the conclusion of each transaction with ISP 115, such as the provision of

information and/or services, the delivery of intangible goods over the Internet, or the

purchase of intangible or tangible goods for later delivery, ISP 115 sends a message back

to Transaction Server 121 indicating the cost associated with the transaction and the

details of the transaction. Transaction Server 121 therefore maintains a record in its

database 122 for each transaction conducted by the user with ISP 115. " and Col 6 lines

36-51 refers to Table 2 which is information stored in database showing client, ISP

Merchant, Amt, Biller etc.

Our claim 5 as representative requires sub-accounts and a password for accessing said.

As mentioned, a sub-account is derivative to a main account but none is evident from the

above. No password is shown above as well. If the examiner considers "a billing

mechanism" found above to be sub-accounts then it must be reasoned as on its own it

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fails to show sub-account. The examiner did not place any reason to modify to show our elements and neither was inherency articulated.

The Applicant respectfully ask the examiner to allows these claims for the reasons above.

<u>Refering to claims 6, 26, 32</u>

Rejection under USC 112 Para 2. (See Action Letter page 4)

For the purpose of this rebuttal, the Applicant is using Claim 6 as the representative.

Basically the elements included in the process in the ORDER of :

1. receiving and storing (in mobile device)
2. verifying transaction (to merchant server)
3. checking the integrity (to payment processor)

The examiner states that it is not clear at all what the step of checking (step 3) is accomplishing since decryption had to occur in the preceding verifying step 2. This plainly ignores that this is a two step process first being to merchant and second to payment processor (both are structurally unrelated).

The applicant respectfully disagree given the examiner provided no official notice that show verifying step must include a decryption at the merchant server. The examiner stated that verifying step must include decryption at Merchant Server (Page 4) . In fact, the merchant server has NO key to decrypt, only payment server has this. So at this stage of downloading to merchant server is merely to compare TWO encrypted data to see if they are the same ie verifying the transaction (step 2) which is NOT the same as checking the integrity of the receipt (step 3) which is forwarded to the payment processor. The

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Applicant suspects the examiner had confused the two steps being applied to Merchant Server ONLY when in fact the two steps are independent applying to merchant server and to payment processor.

The Applicant respectfully submits, the issue of '...not clear at all <u>what the step of checking is accomplishing...</u>' according to the examiner (at page 4) is not a USC 112 Para 2 rejection as the subject matter of 'checking' is clear. In short, not knowing what this step is accomplishing or why is not the same as saying one skilled in the art is uncertain about the boundaries of the checking process. The examiner provided no explanation how one ordinary skilled in the art would not understand the limits of checking. The examiner also states that 'integrity' is a <u>relative</u> word which renders the claim indefinite (at page 4) . The examiner states because there is no standard for ascertaining the requisite degree, one ordinary skill in the art would not be reasonably appraised of the scope of the invention.

MPEP 2173.05(b) states that "If it does not, a <u>determination</u> is made as to whether one of ordinary skill in the art, in view of the prior art and the status of the art, would be nevertheless reasonably apprised of the scope of the invention. Even if the specification uses the same term of degree as in the claim, a <u>rejection may be proper</u> if the scope of the term is not understood when read in light of the specification."

The examiner made no such <u>determination</u> as required and only concluded this is so. By simply reasoning <u>there is no standard for ascertaining in specification</u> does not by itself is conclusive one skilled in the art will fail to ascertain the scope of the invention. Without stating why this term is not understood in light of the specification (which includes original claim 1 which this claim depends on as filed), the examiner had not made out the prima facie case required. A claim is indefinite where those skilled in the art would not understood what is claimed when reading the claim language in light of the specification

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and prosecution history. (Amgen Inc v Chugai Pharmaceutical Co., 927 F.2d 1200, 1218, 18 USPQ 2d 1016, 1030 (Fed Cir)., Cert denied, 502 US 856 (1991))

Generally, a dictionary can be used and "integrity" is defined as

n.

Steadfast adherence to a strict moral or ethical code.

The state of being unimpaired; soundness.

The quality or condition of being whole or undivided; completeness.

Source : The American Heritage® Dictionary of the English Language, Fourth Edition

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This means integrity must means a state of being unimpaired or whole in reference to the receipt. The state of unimpaired, whole or undivided surely is definite since if there is impairment, the payment processor will not be able to decrypt the receipt. For example, prior to decrypting the receipt, it is normal to do a sum test.

<u>Rejection under 103(a) at page 9-10 of Action Letter.</u>

The Action letter further states that Claim 6,26, 32 are unpatentable over combination of Woodhill, Ronen and Fox (US 6560581).

The examiner's conclusion is based on evidencing Abstract and Fig 8 and 9 of Fox. Fig 8 of Fox shows a transaction of passing documents between on party to another and FIG. 9 is a data structure used in the interchange of data between participants in the electronic commerce system. The Applicant fails to see how the two figures are related to downloading to a wireless communication device, verifying transaction and checking integrity. At best Fig 8 shows verifying transaction with merchant server but note that Fox teaches interchange of commerce documents between two trading parties whereas

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the claimed invention here shows using said receipt to exchange for goods and services. Noting that there is nothing to show storing in a wireless communication device (in body of claim).

Fox (US 6560581) in Abstract. This patent relates to systems and methods for secure electronic interchange of commerce documents and instruments by trading participants. In particular, provides an electronic commerce system that facilitates commercial interchange of documents and instruments in a large, unrestricted audience of participants, while supporting the underlying principles of authenticity, integrity, privacy, and security. The system in part relies on a credential binder server which creates unique identifier for each participants and these unique identifiers are used as embedded components in the document and instrument whereupon intended recipients can be authenticated, ie if recipients are not registered (issued with unique identifiers) then they would not be able to open said instrument or document. (Fox distinguishes instrument and document) The integrity check by manipulating such unique identifiers to reveal access rights to either the documents or instruments. Fox also taught of sending both instrument and document together to both recipients. The issuance of receipts are taught at Col 3 Lines 29-34, in part from banker to merchant is a payment guarantee receipt and from merchant to payer as purchase receipt. There is no teaching of using receipt as a way to receive goods and services. (in general, a preamble limits the claimed invention if it recites essential structure or steps, or if it is "necessary to give life, meaning, and vitality" to the claim. Catalina Mktg., 289 F.3d at 808, 62 USPQ2d at 1784 (quoting Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999))). In this instance the preamble clearly states for receiving goods and services which is necessary to give life, meaning and vitality to the claim. For instance because the claim recites steps for doing something to receipt and without understanding what the receipt is for then the body of the claim is without life and vitality.

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There is no teaching of presenting encrypted receipts <u>stored in a wireless communication device</u>. Firstly, the pertinent question is whether storing such documents or instrument for integrity check later is inherent in Fox ? The examiner provided no evidence to show this. If the first crucial step of storing in a wireless communication device is not even found in Fox, then without any inherency explanation, the prima facie case had not been made.

Motivation

The examiner has not provided any motivation to combine to reveal our claimed invention. The examiner merely states " Therefore, one of ordinary skill in the art would have <u>been motivated to extend</u> the combination of Woodhill and Ronen with a method and system further includes the for receiving goods and services comprising receiving and storing an encrypted receipt in payer's wireless communication device; verifying of transaction includes a step of downloading said receipt from the payer's wireless communication device to merchant server and comparing against a copy stored in merchant server; and checking the integrity of the receipt further includes the step of uploading the receipt to the payment processor for decryption." (at page 10) which is conclusory and made no reason to show <u>what</u> is the motivation to extend. The examiner also provided no teaching at all to combine its features with both Woodhill and Ronen. In addition, these claims depend on independent claims which we submitted had not been able to show all claims limitations and for the same reason is not obvious.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to <u>combine the references</u>. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination"). Whether motivation to combine the references was shown is a question of fact. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[P]articular factual findings regarding the

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suggestion, teaching, or motivation to combine serve a number of important purposes . . . .") (emphasis added); Monarch Knitting, 139 F.3d at 881-83, 886, 45 USPQ2d at 1982, 1985 (treating motivation to combine issue as part of the scope and content of the prior art and holding that genuine issues of fact existed as to whether one of ordinary skill in the art would have been motivated to combine the references in question).

As the examiner failed to provide a teaching or motivation, prima facie has not been proven and hence the Applicant respectfully ask the examiner to allow these claims.